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Paper No. 9

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DEC 13 2002

OFFICE OF PETITIONS

In re Application of :
Jon Strong, Jay Werb, and Colin Lanzl :
Application No. 10/036,710 : **DECISION ON RENWED PETITION**
Filed: December 21, 2001 :
Attorney Docket No. P00723/70048 JNA :
Title: METHOD AND APPARATUS FOR :
INTEGRATING WIRELESS :
COMMUNICATION AND ASSET :
LOCATION :

This is in response to the renewed petition under 37 C.F.R. §1.47(a)¹, filed November 11, 2002.

The petition is **DISMISSED**.

NOTICE:

Any request for reconsideration of this decision under 37 C.F.R. § 1.47(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The request for reconsideration should include a cover letter entitled "Second Renewed Petition

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted in this decision, except that the reply may include an oath or declaration executed by the non-signing inventor.

Thereafter, there will be no further reconsideration of this matter^{2, 3}.

On December 21, 2001, the application was deposited, identifying Jon Strong, Jay Werb, and Colin Lanzl as joint inventors. The application was deposited without a fully executed oath or declaration (inventor Strong failed to execute the declaration). On February 26, 2002, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration and a surcharge of \$65.00 were required. This Notice set a two-month period for reply.

The original petition was dismissed for failure to meet the sixth requirement above. The submitted declaration pertained to Application No. 09/791,037, the parent of the instant application. It was determined that the Rule 47(b) applicant must sign on behalf of the non-signing inventors, and the submitted declaration of the parent application is not relevant to the present application⁴.

With the instant petition, a supplemental declaration has been submitted which correctly identifies the instant application, and is executed by a representative of one "RF Technologies". This declaration is defective for the reason discussed below.

The rule 47(b) applicant must make the required oath or declaration. The declaration must state the relationship of the person, making the oath or declaration, to the inventor, and upon information and belief, the facts which the inventor is required to state. Where a corporation is the 47(b) applicant, an officer thereof should normally sign the necessary oath or declaration. Regardless, the title or position of the person signing must be stated. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP 324⁵. Where an application is executed by one other than the inventor,

² For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

³ If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

⁴ See 37 CFR 1.63(d)(3).

⁵ MPEP 409.03(b).

the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(a). Submission of an oath or declaration in compliance with 37 CFR 1.63 and 1.64 is required, as the declaration submitted with the instant petition has been executed by an employee of RF Technologies, but does not reveal the signor's name or title. Alternatively, petitioner may submit a proper declaration executed by both of the non-signing inventors.

In light of the recent events, the USPTO **strongly** prefers that the reply to this letter be submitted by facsimile⁶. However, if applicant cannot submit the reply to this letter by facsimile (or hand-delivery⁷), the reply may be mailed⁸.

Notice regarding fees:

Historically the fees that the USPTO charges for doing business increase at the beginning of each fiscal year (October 1). However, no final determination has been made on fees for FY03 at this point, and fiscal year 2003 was started with the same fee structure as last fiscal year.

Please be advised that applicants should monitor the USPTO website for future updates whenever any necessary money is sent.

For more information, see www.USPTO.gov, click on "News and Notices", and under the "Patents" column you will find the above information⁹.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁶ (703) 308-6916, Attn: Office of Petitions.

⁷ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

⁸ Commissioner for Patents, Box DAC, Washington, DC 20231.

⁹ The direct URL is: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/feenotice.htm>